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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,340	09/26/2006	Albert H.J. Immink	GB 040077	7138
24737 7590 11/24/2009 PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510				
EXAMINER				
LESTER, EVELYN A				
ART UNIT		PAPER NUMBER		
2873				
MAIL DATE		DELIVERY MODE		
11/24/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/599,340

Applicant(s)

IMMINK ET AL.

Examiner

Evelyn A. Lester

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The replacement drawings were received on 9-15-09. These drawings are approved.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a capacitance sensing arrangement comprising a plurality of electrode segments, does not reasonably provide enablement for any and all, future and present, capacitance sensing arrangements. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. It is required to ensure that the scope of the claim is clear so the public is informed of

the boundaries of what constitutes infringement of a patent. The scope of this claim is broader than seems justified by the disclosure.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(f) he did not himself invent the subject matter sought to be patented.

4. Claims 1-25, as far as these claims are understood, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Immink et al published article, dated 8 September 2003, entitled, "Patterned ITO contacts and Cross-Capacitance Sensing (CCS) for measuring the shape of an electro-wetting lens."

Please note the entire article, including all of the Figures. This article is the Applicants' claimed invention. The Figures of the article are the same Figures of the application disclosure.

*** Please note the published date of the article predates the file date of the foreign priority document for this U.S. patent application. The prior art need only predate the foreign priority file date in order for the prior art to be proper under 35 U.S.C. 102. Further, this article predates the effective U.S. file date, as applies under 35 U.S.C. 371,

of March 29, 2005, by more than one year. Therefore, the article qualifies as prior art under 35 U.S.C. 102(b). ***

5. Claims 1-25, as far as these claims are understood, are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. Please note that the authorship of the Immink et al published article (indicated above, in the prior art rejection, paragraph 4) is different from the inventorship or inventive entity of the Applicants' claimed invention. Since the published article reads on the claimed invention, it is not clear why the authorship and inventorship are different.

Response to Arguments

6. Applicant's arguments, see page 11-13, paragraphs I. A., filed 9-15-09, with respect to the prior art rejection, as anticipated by Herbert (U.S. Patent Pub. 2001/0024486 A1) have been fully considered and are persuasive. The rejection of claims 1, 2, 21, 22, 24 and 25, with Herbert, has been withdrawn.

Applicant's arguments filed 9-15-09, with respect with the rejection under 102(b) as being anticipated by the published article by Immink et al, have been fully considered but they are not persuasive. The Applicant's argument that the article by Immink et al was an internal Philips publication based on a "good faith belief" is not well received and considered to be insufficient to overcome the rejection. Internal publications are not necessarily confidential or prohibited from dissemination. Further, a "good faith belief" is

insufficient as a positive statement to establish that the document was never released to the public prior to the application's filing date. The person making such a statement would have to be someone in position of authority to state whether this article was intended to be an internal document or not. The person who makes this statement would have to establish their credentials for this statement.

The Applicant provided no remarks or arguments with respect to the claim rejection under 102(f). The rejection is hereby maintained.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn A. Lester whose telephone number is (571) 272-2332. The examiner can normally be reached on M-F, subject to an increased flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky L. Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Evelyn A. Lester/
Primary Examiner
Art Unit 2873